

Appl. No. **09/934,549**
Amdt. dated 02/27/2007
Response to Office Action of 12/07/2006

Attorney Docket No.: TS01-285
N1085-90132

1 **Amendment to the Drawing:**

2 Please amend the drawing by replacing Figure 2 with the new Figure 2 attached
3 hereto (in the Appendix) on a Replacement Drawing Sheet.

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7 Attachment: One Replacement Drawing Sheet

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REMARKS/ARGUMENTS

Claims 1-8 are presently pending in this Application and each of claims 1-8 has been rejected. Claims 1, 4 and 7 are being amended. Applicants respectfully request re-consideration and allowance of each of pending claims 1-8.

5 I. Objection to the Drawings

The drawings were objected to under 37 CFR 1.83(a) because they fail to adequately show the reticle box and reticle as in claims 2, 4 and 7. Figure 2 has been replaced with a new Figure 2 which illustrates these features.

10 Because new Figure 2 adequately shows the claimed reticle box and reticle, the drawing now complies with the requirements of 37 CFR 1.83(a) and therefore the objection to the drawing should be withdrawn.

II. Claim Rejections Under 35 USC § 112

15 In paragraph 5 of the Office Action, claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action contends that the recitation in the claims of "Cartesian coordinates" is vague and indefinite for failing to clearly define the metes and bounds of the claimed invention. Applicants respectfully traverse.

20 Applicants respectfully submit that the recitation in the claims of Cartesian coordinates provides a suitable means for describing the relative configuration and orientation of the claimed components. The three-dimensional Cartesian coordinate system is well-accepted and understood as a means for describing three-dimensional features. Applicants provide herein a description of the Cartesian coordinate system taken from: http://en.Wikipedia.org/Wiki/Cartesian_coordinates; as viewed on February 13, 2007.

25 Applicants respectfully submit that the use of and recitation of Cartesian coordinates in the claims to describe the relative configuration of the claimed features,

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assists in keeping the claims brief and concise. Applicants further submit that the use of the Cartesian coordinate system is the clearest way to describe the claimed features and most efficient use of language. The use of the Cartesian coordinate system is sufficiently definite and complies with the requirements of 35 U.S.C. § 112, second
5 paragraph.

The claim rejections under 35 U.S.C. § 112, second paragraph, should therefore be withdrawn.

III. Claim Rejections Under 35 USC § 103

In paragraph 8 of the subject Office Action, claims 1-8 were rejected under 35
10 U.S.C. § 103(a) as being unpatentable over USP 6,421,113 to Armentrout in view of USP 4,999,617 to Iizuka, USP 5,787,057 to Fan, USP 6,454,512 to Weiss, Germany 3917874 to Seibert, USP 4,293,095 to Veralrud, and USP 5,873,585 to Engelking. Applicants respectfully submit that these claim rejections are overcome for reasons set forth below.

15 The rejected claim set includes independent claims 1 and 4. Independent claim 1 has been amended. Independent claim 1 recites the features of:

a platform having a first and second surface opposite said first surface, said wheels being attached to said first surface of said platform;

20 shock absorbers, being mounted on the second surface of said platform; and

an upper portion disposed **over** said shock absorbers, said shock absorbers forming an **interface between** said platform and said upper portion.

25 Independent claim 4 has been amended. Independent claim 4 recites the features of:

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said lower portion further comprising a platform having a first
and an opposed second surface, said wheels being attached
to said first surface of said platform,

shock absorbers mounted on the second surface of said
platform; and

said shock absorbers **disposed between** said platform and
said upper portion.

Independent claims 1 and 4 therefore recite the feature that the shock absorbers
are between the lower portion consisting of the platform and wheels, and the upper
portion.

In rejecting the claims, the Office Action refers to the Weiss reference as
teaching shock absorbers. In the Weiss reference, the shock absorbers 32 are
illustrated in figures 3, 5, 6, 7 and 9-12. The shock absorbers illustrated in figures 3 and
5-7 are disposed over a surface, with wheels attached to the opposite side of the
surface. The shock absorbers clearly DO NOT form an interface between a lower plate
and an upper portion, nor are they "between" a lower plate and an upper portion. The
shock absorbers illustrated in figures 9-12 appear to be disposed directly over the
wheels, and not in between a lower plate and an upper portion. Weiss stands as the
only reference relied upon for providing shock absorbers and the configuration of the
claimed shock absorbers distinguishes the claimed shock absorbers from those
provided in Weiss.

As such, independent claims 1 and 4 are distinguished from the references of
record for at least these reasons. Dependent claims 2-3 and 5-8 are similarly
distinguished from the references by virtue of their dependency from claims 1 and 4,
respectively.

Moreover, Applicants respectfully submit that the claim rejections under 35
U.S.C. § 103(a) are merely speculative and that the Examiner has impermissibly used

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hindsight reconstruction to select particular features from SEVEN different references to arrive at the inventive combination of features as claimed.

The unrelated elements from the different disclosures do not render the combination thereof, obvious, as alleged by the Examiner. The Examiner impermissibly combined the references using hindsight reconstruction. Applicants respectfully submit that the Examiner has simply and impermissibly relied upon hindsight to arrive at the determination of obviousness. "It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teaching of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) at USPQ2d 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

It is a combination of limitations that are non-obvious under the conditions of 35 U.S.C. § 103, even though some of the limitations may be separately known. Applicants submit that a holding that combination claims are invalid based merely upon finding similar elements in separate prior art patents would be contrary to statute and would defeat the congressional purpose in enacting title 35. *Smithkline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 8 USPQ2d 1468 (Fed. Cir. 1988). A patented invention cannot be invalidated piecemeal by finding individual features separately in the prior art. The hindsight reasoning employed in using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention. Applicants respectfully submit that the Examiner has not shown some suggestion or motivation, before the invention itself, to make the claimed combination as required in *Ruiz v. AB Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004).

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The Applicants respectfully submit that the Examiner has not shown any suggestion to make the claimed combination because there is no such suggestion to combine in the references of record and point out that a determination of obviousness must involve more than indiscriminately combining prior arts; a motivation or suggestion to combine must exist. *Micro Chem, Inc. v. Great Plains Chemco*, 103 F.3d 1538, 41USPQ2d 1238 (Fed. Cir. 1997). Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929, at 933 (Fed. Cir. 1984).

The Examiner has not upheld the burden of identifying this motivation or suggestion in the prior art to combine the references as such, because, as discussed above, *there is no motivation or suggestion in* either of the references to combine them to provide the claimed features because the references are drawn to different arts, i.e., the Photolithography System Including a SMIF Pod and Reticle Library Cassette Designed for ESD Protection of Armentrout; the Reticle Conveying Device of Iizuka; the CD-ROM Testing Apparatus of Fan; the Person-Guided Vehicle of Weiss; the Shelving Unit for Medicinal Containers of Seibert; the Cabinet for Holding Magnetic Tape Cartridges and Cassettes of Veralrud; and the Self-Leveling Wafer-Lot Cart of Engelking.

In summary, A] the references were impermissibly combined using hindsight reconstruction, and B] the combination falls short of the claimed invention of claims 1 and 4 because the claimed shock absorbers are clearly distinguished from the shock absorbers provided in the Weiss reference. As such, the rejection of claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over the seven references of record, should be withdrawn.

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CONCLUSION

Based on the foregoing, each of pending claims 1-8 is in allowable form and the application in condition for allowance, which action is respectfully and expeditiously requested.

- 5 The Assistant Commissioner for Patents is hereby authorized to charge any fees necessary to give effect to this filing or credit any excess payment that may be associated with this communication to deposit account 04-1679.

Respectfully submitted,

10 Dated: 27 FEBRUARY 2007



15 Mark J. Marcelli, Reg. No. 36,593
Attorney for Applicant

20 Attachment: Appendix with New Drawing sheet (Fig. 2)
Printout of: http://en.Wikipedia.org/wiki/Cartesian_coordinates, as viewed
on February 13, 2007.

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APPENDIX